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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,914	09/20/2002	Arne Stavland	2002-0417A	2771

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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,914

Applicant(s)

STAVLAND ET AL.

Examiner

Philip C. Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 31-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 31-37, 44-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Vanderhoff (3284393).

Vanderhoff teaches a water in oil emulsion comprising an aqueous gellant emulsified in oil, wherein the level proportions of water and oil within the scope of the present invention, and of polymer as low as 5% of the aqueous phase (see column 1, line 66 – column 2, line 7 and the examples). Such would inherently break within the same time frame as in claim 48. Applicants intended use does not distinguish over the prior art (In re Pearson 181 USPQ 641).

3. Claims 31-37 and 44-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson (3624019).

Anderson teaches a water in oil emulsion comprising an aqueous gellant emulsified in oil, wherein the level proportions of water and oil within the scope of the

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present invention, and of polymer as low as 2% of the aqueous phase (see column 3, lines 33-36, and column 2, line 65- column 3, line 19). Such would inherently break within the same time frame as in claim 48. Applicants intended use does not distinguish over the prior art (In re Pearson 181 USPQ 641).

4. Claims 31-37, 44-57 and 63-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Quintero (6204224).

Quintero teaches a water in oil emulsion comprising an aqueous gellant emulsified in oil, wherein the level proportions of water, polymer and oil within the scope of the present invention (Tables I-III and column 3, lines 39-43). Such would inherently reduce water permeability more than oil permeability, and break within the same time frame as in claim 48.

5. Claims 31-37, 44-57 and 63-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips (4284304).

Phillips teaches a water in oil emulsion comprising an aqueous gellant emulsified in oil, wherein the level proportions of water and oil within the scope of the present invention, and of polymer as low as 5% of the aqueous phase (see abstract and column 5, lines 44-63). The emulsion is used in subterranean formations. Such would inherently reduce water permeability more than oil permeability, and break within the same time frame as in claim 48.

6. Claims 31-37 and 44-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips (4283507).

Phillips teaches a water in oil emulsion comprising an aqueous gellant emulsified in oil, wherein the level proportions of water and oil within the scope of the present invention, and of polymer as low as 5% of the aqueous phase (see column 1, lines 60-column 2, line 9). Such would inherently break within the same time frame as in claim 48. Applicants intended use does not distinguish over the prior art (In re Pearson 181 USPQ 641).

7. Claims 31-38,44-57 and 63-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Bleeker (4670550).

Bleeker teaches a water in oil emulsion comprising an aqueous gellant emulsified in oil, wherein the level proportions of water and oil within the scope of the present invention, and of polymer as low as 1% of the aqueous phase (see column 1, lines 66-column 2, line10). The emulsion is used in subterranean formations (column 1, lines 12-16). Such would inherently reduce water permeability more than oil permeability, and break within the same time frame as in claim 48.

8. Claims 31-37 and 44-56 and 63-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Dawson (5735349).

Dawson teaches a water in oil emulsion comprising an aqueous gellant emulsified in oil, wherein the level proportions of water and oil within the scope of the

present invention (see Examples 1 and 2). Such would inherently break within the same time frame as in claim 48. Dawson teaches that the emulsion reduces water permeability greater than oil permeability.

9. Claims 31-38,44-57 and 61-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Sunde (5919739).

Sunde teaches a water in oil emulsion comprising an aqueous gellant emulsified in oil, wherein the level proportions of polymer, water and oil within the scope of the present invention (see column 2, lines 6-22). The emulsion is used in subterranean formations (column 1, lines 6-19). A crosslinker is included in the oil phase which anticipates claims 61 and 62. Such would inherently reduce water permeability more than oil permeability, and break within the same time frame as in claim 48.

10. Claims 31-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Le et al (6169058).

Le teaches a water in oil emulsion comprising an aqueous gellant emulsified in oil, wherein the level proportions of polymer, water and oil within the scope of the present invention (see column 6, lines 16-19 and Example 1). The emulsion is used in subterranean formations (column 1, lines 6-19). A crosslinker is included in the aqueous phase which can be a trivalent metal ion (column 14, lines 52-55). Such would inherently reduce water permeability more than oil permeability, and break within the same time frame as in claim 48.


11. Applicants arguments have been considered but are not deemed persuasive. Initially it is pointed out that claims 50-56 and 63-68 were inadvertently not rejected over Dawson in the first action. Since Dawson clearly teaches that the water permeability is reduced to a greater level than the oil permeability, the claims are rejected by Dawson (see column 2, lines 10-16). Applicants reference to the method of making the polymer of the gelant as distinguishing is clearly incorrect. Whether the references such as Dawson, Phillips or Vanderhoff teach the formation of the polymer is immaterial, since the final product obtained is the same aqueous gelant emulsified in oil as the present invention. Applicant is claiming an aqueous gelant emulsified in oil, the intended use for reducing water permeability more than oil permeability is not seen as a distinguishing factor, since the courts have held that an intended use does not distinguish over the prior art (In re Pearson 181 USPQ 641). Furthermore, the same polymers are used at the same levels in the emulsions, or in treating the subterranean formations, and must thus inherently have the same properties, absent a showing by applicant to the contrary. With respect to Bleeker, the "enhanced oil recovery" process is one in which the composition is introduced into the subterranean formation to increase the production of oil from the well, and thus increases the permeability of oil compared to water in the well, thus in effect reducing the water permeability more than the oil permeability. With respect to Sunde, applicant has not shown that the plugging of the well will not reduce the water permeability more than the oil permeability, and clearly is within the scope of

spent wells having more water production than oil production. The rejections are thus maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C. Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Philip C Tucker
Primary Examiner
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